

REMARKS

Claim Rejections

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art identified in Figs. 1 and 2 of this application in view of any one of Lester (U.S. 2,639,481), Howe, Jr. (U.S. 3,110,945) or Vogiatzis (U.S. 4,071,964).

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

New Claims

By this Amendment, Applicant has canceled claims 1-3 and has added new claims 4-8 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a shoelace structure comprising: an integrally woven shoelace (30) having: two opposing ends (31), each of the two opposing ends being narrowed and bound; two tying sections (32) located between the two opposing ends, one of the two tying sections being adjacent to each of the two opposing ends, each of the two tying sections having a plurality of first bulging portions (321) and a plurality of first narrowed portions (322), each of the plurality of first narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of first bulging portions, one of the plurality of first narrowed portions being located adjacent to each of the plurality of first bulging portions; and a passage section (33) located between the two tying sections and having a plurality of second bulging portions (331) and a plurality of second narrowed portions (332), each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions, one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

Other embodiments of the present invention include: each of the plurality of first bulging portions having one of a round and an elongated cross section; each of the plurality of first narrowed portions having one of a round and an elongated cross section; each of the plurality of second bulging portions having one of a round and an elongated cross section; and each of the plurality of second narrowed portions having one of a round and an elongated cross section.

The primary reference to Applicant's Admitted Prior Art teaches a shoelace (10) having a tying section (11) located at each of two opposing ends thereof. Each tying section (11) having a plurality of narrowed parts (111).

Applicant's Admitted Prior Art does not teach a passage section having a plurality of second bulging portions and a plurality of second narrowed portions; each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions; nor does Applicant's Admitted Prior Art teach one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

The secondary reference to Lester teaches a shoelace having protuberances located on an outer surface and extending outwardly.

Lester does not teach each of the two tying sections having a plurality of first bulging portions and a plurality of first narrowed portions; each of the plurality of first narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of first bulging portions; one of the plurality of first narrowed portions being located adjacent to each of the plurality of first bulging portions; a passage section having a plurality of second bulging portions and a plurality of second narrowed portions; each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions; nor does Lester teach one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

The secondary reference to Howe, Jr. teaches a shoelace having an outer covering (12) with a cavity (16) and a flexible body member (18) having protuberances (20) at spaced intervals.

Howe, Jr. does not teach each of the two tying sections having a plurality of first bulging portions and a plurality of first narrowed portions; each of the plurality

of first narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of first bulging portions; one of the plurality of first narrowed portions being located adjacent to each of the plurality of first bulging portions; a passage section having a plurality of second bulging portions and a plurality of second narrowed portions; each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions; nor does Howe, Jr. teach one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

The secondary reference to Vogiatzis teaches chain show lace having a metal chain (5) having metal wires (5a) terminating in balls (7) and connected by a sleeve (6a).

Vogiatzis does not teach each of the two tying sections having a plurality of first bulging portions and a plurality of first narrowed portions; each of the plurality of first narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of first bulging portions; one of the plurality of first narrowed portions being located adjacent to each of the plurality of first bulging portions; a passage section having a plurality of second bulging portions and a plurality of second narrowed portions; each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions; nor does Vogiatzis teach one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

Even if the teachings of Applicant's Admitted Prior Art, Lester, Howe, Jr., and Vogiatzis were combined, as suggested by the Examiner, the resultant combination does not suggest: a passage section having a plurality of second bulging portions and a plurality of second narrowed portions; each of the plurality of second narrowed portions having an outer periphery smaller than an outer periphery of each of the plurality of second bulging portions; nor does the combination suggest one of the plurality of second narrowed portions being located adjacent to each of the plurality of second bulging portions.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which

allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Applicant's Admitted Prior Art, Lester, Howe, Jr., or Vogiatzis that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Applicant's Admitted Prior Art, Lester, Howe, Jr., nor Vogiatzis disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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